

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on May 18, 2007, the Examiner rejected Claims 2–7 under 35 U.S.C. § 112, second paragraph, as being indefinite, rejected claims 1–7 under U.S.C. § 112, second paragraph, as being indefinite, rejected claims 11–12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,807,533 to Land et al. (hereinafter “Land”) in further view of U.S. Patent Application Publication No. 2002/0046049 to Siegel et al. (hereinafter “Siegel”), and rejected claims 1–10 under 35 U.S.C. § 103(a) as being unpatentable over Land in further view of Siegel in further view of U.S. Publication No. 2003/0018574 to Shumway et al. (hereinafter “Shumway”). Accordingly, Applicant respectfully provides the following.

Claim Rejections under 35 U.S.C. § 112, Second Paragraph

In the Office Action, the Examiner rejected claims 2–7 under 35 U.S.C. § 112, second paragraph, as being indefinite. Accordingly, claim 2 has been amended to overcome the § 112 rejection. The amendment also overcomes the § 112 rejections to dependent claims 3–7, which depend from claim 2.

The Examiner also rejected claims 1–7 under U.S.C. § 112, second paragraph, as being indefinite. Applicant respectfully traverses the rejection. The test for definiteness under 35 U.S.C. § 112, second paragraph, as set forth in the M.P.E.P. § 2173.02, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088

(Fed. Cir. 1986). The Examiner asserts that the phrase “reward the business” appears to be directed to individuals in claims 3 and 4 and interprets the term business as comprising actual business and business employees. As shown by the Examiner, the term “business” is understood in the art to include actual business as well as individuals associated with a business. Since one skilled in the art may readily understand the term “business” and, therefore, the claimed subject matter of the present application, Applicant respectfully requests that the rejection be withdrawn.

Claim Rejections under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claims 11–12 under 35 U.S.C. § 103(a) as being unpatentable over Land in further view of Siegel. M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: “Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) Additionally, one helpful standard for a Section 103 rejection is set forth in M.P.E.P. 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there **must be some suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, **to modify the references or combine reference teachings**. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Applicant respectfully submits that the references cited by the Examiner, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Applicant also respectfully submits that there is no suggestion or motivation to combine the references in the manner suggested by the Examiner, and that one of skill in the art would not reasonably expect success in combining the references in the manner provided.

Claim 11 requires “certifying an individual to receive a reward for providing at least one in a series of unpaid debts to a collection entity, wherein the reward includes one or more non-monetary incentives,” and “providing the reward to the certified individual upon providing the unpaid debt to the collection entity.” Such limitations are not taught by the cited references, either alone or in combination. Neither Land nor Siegel discloses any certification of an individual to receive a reward for providing an unpaid debt to a collection entity or providing the reward to the certified individual upon providing the unpaid debt to the collection agency. Land teaches an internal performance evaluation given to credit officers based upon their ability to work delinquent accounts. (Col 11 lines 53-60) Land also teaches that some debts are placed with an outside collection agency. (Col 13 lines 13-18) Nothing in these passages of Land discusses any certification of an individual to receive a reward or providing a reward to a certified individual upon providing the unpaid debt to the collection agency.

Siegel teaches that customer service representatives receive non-monetary awards, including performance awards. (Para [0043]) Nothing in the cited portions of Siegel teach either the certification of an individual to receive a reward for providing an unpaid debt to a collection entity or providing the reward upon the provision of the unpaid debt to the collection entity.

Instead, the incentives of Siegel are entirely internal incentives that are entirely unrelated to the provision of unpaid debts to collection entities. Since neither Land, Siegel, nor the combination thereof teach non-monetary incentives rewarded for presenting unpaid debts for collection, the prior art references fail to teach or even suggest all the claim limitations of claims 11–12. Therefore, Applicant respectfully requests that the rejections be withdrawn.

The Examiner rejected claims 1–10 under 35 U.S.C. § 103(a) as being unpatentable over Land in further view of Siegel in further view of Shumway. Claim 1 requires, “the collection agency rewarding the business providing the unpaid debt, wherein the reward given to the business from the collection agency includes a non-monetary incentive to forward more unpaid debt.” The Examiner continues to rely on an unrelated internal incentive that fails to teach the claimed reward from the collection agency to the business providing the unpaid debt to the collection agency. Therefore, Land and Siegel fail to teach the recited limitation of claim 1 for the same reasons discussed above with respect to claim 11. In addition, the discount pricing incentive discussed in Shumway can in no way be considered a non-monetary incentive, as pricing is clearly a monetary incentive. Additionally, nothing discussed by the Examiner shows that one of skill in the art would find the discount pricing of Shumway at all relevant to the discussion of performance reviews within a business as discussed by Land.

The Examiner fails to show any suggestion or motivation in Land, Siegel, or Shumway to combine the teachings in the prior art references in the manner suggested by the Examiner, as is required by the M.P.E.P. § 706.02(j). A “clear and particular” showing of the suggestion to combine is required to support an obviousness rejection under Section 103. M.P.E.P. § 2142.

Indeed, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). The Examiner fails to show in any way that the discount pricing discussed by Shumway is at all relevant to or combinable with the internal performance reviews discussed by Land and Siegel. In making the proposed combination, the Examiner has failed to cite to any passage of any of the three references that supports the proposed combination. Therefore, the Examiner has failed to show that there is any motivation to combine the references in the manner suggested by the Examiner and has failed to show that one of skill in the art would arrive at the claimed invention by making the combination.


Claims 2-10 depend from claim 1 and are at least allowable for the same reasons. Applicant therefore respectfully requests that the rejections be withdrawn because the cited references fail to teach all claim limitations and because there is no motivation or suggestion for combining reference teachings or indication of a possibility of success in arriving at the claimed invention.

CONCLUSION

If any impediments to the allowance of this application for patent remain after the above amendments and remarks are entered, the Examiner is invited to initiate a telephone conference with the undersigned attorney of record.

Dated this 20 day of August, 2007.

Respectfully submitted,


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